

WRITTEN COMMENTS ON:
ELIMINATION OF CONTINUED PROSECUTION APPLICATION PRACTICE
AS TO UTILITY AND PLANT PATENT APPLICATIONS

Submitted on behalf of:
The National Association of Patent Practitioners

September 7, 2001

Responsive to the notice appearing in the Federal Register at Volume 66, Number 131, July 9, 2000, pages 35763-35765, the National Association of Patent Practitioners (NAPP) hereby submits written comments against the proposed elimination of CPA practice in utility and plant patent applications.

Our Association

The NAPP is a nonprofit organization dedicated to supporting patent practitioners and other individuals working in the field of patent law, in matters relating to patent law, its practice, and technological advances. Seventy-five percent (75%) of our members are registered patent practitioners whose practice is directed primarily toward patent prosecution. As part of our mission, we aim to create a collective, nationwide voice to respond to proposed changes in the patent statutes, rules, and PTO operations with a view to their impact on patent prosecution practice and the American inventor community. With this in mind, we appreciate the opportunity to provide our comments and suggestions on this important matter.

Comments Against Eliminating CPA Practice

The NAPP is against eliminating CPA practice because the rule change will have several adverse effects on both the USPTO and the applicants/practitioners without providing any real benefit to either. The proposed rule change would eliminate a procedural device for filing utility applications. The rule change would thus invoke a major change in patent practice and should not be casually enacted. Further, no other procedural device is equivalent to a CPA. Contrary to the statements in the Federal Register Notice, a CPA is not redundant to an RCE. Finally, given the numerous changes that have recently occurred, this change would only add to the confusion and uncertainty encountered by practitioners and consequently increase the chances for mistake. These reasons are expressed more fully below.

1. Practical Adverse Consequences of the Proposed Rule Change

- The only vehicle for filing a continuation application will be Rule 53(b). Under 53(b), the USPTO will receive a complete copy of the application that it already has in its file. This inefficient practice was recognized decades ago, leading to File Wrapper Continuation (FWC) practice (Rule 62 - now reserved), and then to CPA practice. Removing CPA's means that the applicants must bear the burden of copying and re-filing their applications if a continuation application is sought. Similarly, the USPTO will receive more paper that it must handle, track, and store.
- The number of unintentionally abandoned applications will increase. As recognized in the Federal Register Notice, experience has already shown that applicants sometimes file a CPA when only an RCE is permissible. The CPA submission frequently does not meet all the requirements for an RCE and is thus non-responsive. If no additional time is available for response, then the application is abandoned and applicants must file an expensive petition to

revive under Rule 137. The present USPTO experience is merely a foreshadowing of the unintentional abandonments to come if this proposed rule change is adopted. The USPTO should consider how many FWC's were filed after Rule 62 was reserved that were treated by the Office as if they were CPA's in order to prevent abandonment. Here, the Office, by its own recognition, is likely to be unable to treat a CPA as an RCE because of the different filing requirements and thus will have a significant increase in abandonments. This will increase the burden on the Office of Petitions as well as on applicants/practitioners.

- The USPTO will have to expend more time and energy in re-training staff on how to handle CPA's after the rule change. This additional training comes just after the USPTO trained the staff on how to handle CPA's under the current scheme. That training will now be largely wasted and new training will instead be required.
- The USPTO will likely expend more time and energy in revamping its external training programs that it provides to the public. Like the internal training, portions of these programs that were only recently prepared, will have to be thrown out and replaced with newly created material. Further external training will need to be provided to practitioners around the country, resulting in further expense to the Office.

2. CPA's Are Not Redundant With RCE's

- A CPA can be filed to change the elected invention; i.e. a divisional CPA. RCE practice prohibits switching inventions because it is the same application - not a divisional application.
- A CPA application can be filed without a "submission" while an RCE must have a submission. Thus, if applicants do not know when comparative test data will be ready and simply want to file a continuation and then submit data, applicants would have to file a 53 (b) application including a copy of parent application. This is a classic use of an FWC-like procedure, but one that is not possible under RCE practice.
- A CPA can be filed before final rejection, while an RCE can only be filed after prosecution on the merits is closed. For example, if a practitioner does not have instructions for responding to a first Office Action (or does not have time to prepare a response because the instructions were received late), presently a CPA can be filed to maintain the pendency of the subject matter. An RCE does not permit such a filing because (1) it is too early and (2) it lacks a "submission." In this example, the lack of a "submission" is the very reason that applicants seek a continuing device. If the rule change is adopted, then applicants in this situation will have to file a 53(b) application which takes longer to prepare, proof and file than a CPA.
- A CPA is treated differently for patent term adjustment than an RCE. In some cases it may be advantageous to file a CPA instead of an RCE such as when final rejection is issued quickly.

3. CPA's are Unlikely to be More Expensive Than The Alternative

- A CPA has the same filing fee as a new application but less paper work for both the USPTO and the applicant.
- A CPA is easier to examine than a new application because the Examiner has likely already searched the claimed subject matter and has already identified issues of patentability.
- When an applicant needs to file a continuation application and not merely continued examination, a 53(b) application is the only alternative. A 53(b) application cannot be less costly to process than a CPA. Comparing the cost of the CPA to the RCE is not the correct comparison because they are not the same.

- Co-presence of CPA and RCE does not prevent applicants from using RCE. Where appropriate to the applicants' goals, the allegedly "cheaper" RCE procedure will be followed.
- The costs analysis should include the training costs described above as well as the cost in handling more 53(b) continuations and petitions to revive unintentionally abandoned applications. Given that CPA's will gradually sunset under the current plan within a few years, changing the rules now seems to be the most costly option.

CPA's are a convenience to the practitioner and the USPTO. They provide a valuable procedure for filing a continuation or divisional application in a streamlined fashion that is not possible with RCE practice. Given that CPA's will sunset under the present rule (no application filed after May 29, 2000 can be filed as a CPA), given that great amounts of training both inside and outside of the USPTO have already been expended, and given that changing the rule would cause an increase in training and operating costs both inside and outside the USPTO, we strongly recommend that the USPTO not adopt the proposed rule change.

Thank you for consideration of our comments.

Respectfully submitted,

The National Association of Patent Practitioners
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